

REMARKS

No further amendments are presented.

Claims 1-16 are pending in the application.

If any extension of time is required, please consider this paper a petition for the total extension of time required.

It is believed that no fee is due in connection with this paper. In the event that a fee is due, kindly refer to the general Deposit Account Authorization previously filed with the application.

The Effective Filing Date

The Office Action asserted (p. 2, par. 2) that the claimed inventions were not entitled to the benefit of the March 2003 provisional filing date, because certain limitations were said only to be supported by the December 2003 nonprovisional disclosure.

The only reason the Office has given why the effective filing date might make any difference was that the later, nonprovisional date might allow one of the inventors' earlier presentations to be cited against the claims, where the earlier provisional date would not.

However, for the reasons discussed below, it is respectfully submitted that the §102(b) rejection should be withdrawn. Once the § 102(b) rejection has been withdrawn, the effective filing date question becomes moot.

The § 102(b) Rejection

A single ground of rejection was entered: Claims 1, 2, 4-11, and 16 were rejected as being anticipated by the Vaidya *et al.* November 2002 presentation.

Claims 3, 12, 13, and 15 were found to be allowable in substance, but were objected to on formal grounds as being dependent upon a rejected base claim.

It is impossible for the Vaidya *et al.* presentation to anticipate any Claim in this patent application, for the reasons discussed below.

The inventors are identical to the authors of the cited presentation.

There are three inventors in the present, nonprovisional application 10/734,816: Steven A. Soper, Robin L. McCarley, and Bikas Vaidya.

The priority provisional application S.N. 60/458,319 had the same three inventors: Steven A. Soper, Robin L. McCarley, and Bikas Vaidya.

The Vaidya *et al.* presentation named the same three individuals as authors, although they were named in a different order: Bikas Vaidya, Steven A. Soper, and Robin L. McCarley.

In other words, authorship and inventorship are completely identical.

Where the inventors and the authors are identical, § 102(b) provides the only statutory basis that might potentially support an anticipation rejection — but only if the right set of facts exists, which they do not.

Of the various subsections of 35 U.S.C. § 102, only § 102(b) provides even a potential basis for a hypothetical argument that a claimed invention might be anticipated by the inventors' own publication — but only where the right set of facts exist, which they do not here.

Subsection (a) of 35 U.S.C. § 102 applies to publications, patents, knowledge, and use “by others.” Subsections (c), (f), and (g) concern events other than publications. Subsection (d) refers to a specialized situation involving a foreign patent application and a foreign patent by the same applicant. Subsection (e) applies to patents or patent applications filed “by another.”

Only § 102(b) might — given the right set of facts — potentially support an anticipation rejection based on the inventors' own publication.¹

¹ Subsection 102(d) might arguably be said to do so as well, but § 102(d) concerns a highly specialized situation that is plainly inapplicable here.

The Vaidya et al. presentation was published less than one year before the priority provisional filing date, and therefore may not be cited against claims that are supported by the provisional disclosure.

35 U.S.C. § 102(b) reads, in pertinent part: “A person shall be entitled to a patent unless — (b) the invention was . . . described in a printed publication . . . more than one year prior to the date of the application for patent”

The Vaidya *et al.* presentation was given in November 2002. The provisional priority application was filed in March 2003. The present, nonprovisional application was filed in December 2003.

The Vaidya *et al.* presentation was given less than one year before the provisional priority filing date, but more than one year before the nonprovisional filing date. It is hypothetically possible — in principle, before one examines the actual details — that a publication by the inventors, made less than one year before a provisional filing date but more than one year before a nonprovisional filing date, might be cited as anticipating a claim in the nonprovisional application.

But such a publication can only anticipate if it teaches some aspect of the claimed invention that is not also taught by the provisional disclosure. A teaching from the publication cannot anticipate where the identical teaching is also found in the provisional disclosure. To the extent that the provisional disclosure repeats the teachings of the publication, the publication cannot be a statutory bar, and it may not be cited as anticipating.

A straightforward corollary is that there can be no anticipation by the inventors' own publication, made less than one year before the provisional filing date, where the entire disclosure of the publication is duplicated within the provisional application. Whatever is taught by the publication is, necessarily, also taught by the provisional application.

Put differently, to support this rejection the Office would need to identify some teaching in the presentation that does not also appear in the provisional disclosure. But there are no such teachings.

The substance of the Vaidya et al. presentation is entirely duplicated within the provisional application. Therefore the presentation cannot anticipate any claim in this application.

Inspection will readily show that the substance of the Vaidya *et al.* presentation is entirely duplicated within the provisional application. In many cases the corresponding passages are verbatim identical, or nearly so. In other cases, the wording varies slightly. In some cases the provisional application adds additional disclosure. But it omits nothing that was in the presentation.

The correspondence between the presentation and the relevant portions of the provisional application is illustrated in an Appendix below. The Appendix presents a detailed table showing which passages in the provisional application correspond to each of the passages in the presentation. The presentation contained nothing of substance that was not duplicated in the provisional application.

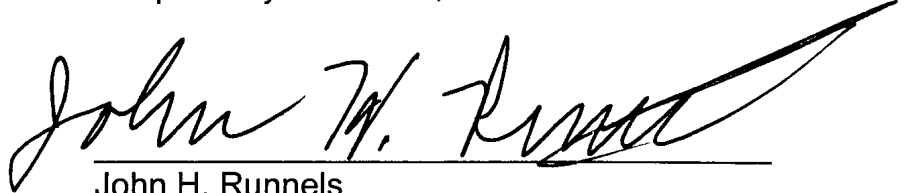
It is impossible for the Vaidya *et al.* presentation to anticipate any Claim in this patent application: **(1)** Any claimed invention that is taught by the Vaidya *et al.* presentation is necessarily entitled to the benefit of the provisional filing date; and the Vaidya *et al.* presentation is then not a statutory bar. **(2)** Any claimed invention that, hypothetically, is not supported by the provisional disclosure, and that must rely on the nonprovisional filing date, is necessarily novel over Vaidya *et al.* presentation. In neither case can the Vaidya *et al.* presentation anticipate any Claim in this patent application.

It is respectfully submitted that the § 102(b) rejection should be withdrawn.

Conclusion

Allowance of Claims 1-16 at an early date is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John H. Runnels", is written over a horizontal line.

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Appendix
Correspondence between Passages in the Vaidya et al. Presentation
and those in the Priority Provisional Application

Vaidya et al. Presentation (November 2002)	Provisional Application 60/458,319 (March 2003)
Title , p. 1	Title : The five-word title is identical to the first five words of the Presentation's title. The substance of the last four word's of the Presentation's title, "used in microanalytical devices," is found in several locations, including for example line 5 of the "Introduction" on p. 1
Authors , p. 1	Inventors , p. 1: Same three individuals, listed in a different order. Also note the identical institutional and departmental affiliations.
Abstract , p. 1	Abstract , p. 1: Nearly verbatim identical, with the final sentence added in the provisional disclosure.
Keywords , p. 1	Keywords , p. 1: Verbatim identical
Introduction , p. 1	Introduction , p. 1: Nearly verbatim identical, with the third through fifth sentences added in the provisional disclosure.
Experimental , p. 1	
First par., 1st sentence	1st sentence on p. 2: Same substance, with some additional material added to the provisional disclosure
First par., 2nd sentence	2nd full paragraph on p. 2: Verbatim identical
Second par.	3rd full paragraph on p. 2: Verbatim identical, except that the footnote numbers (referring to the same references) differ.

Results and Discussions	
Par. bridging pp. 1 and 2	4th full paragraph on p. 2: Verbatim identical
Fig. 1 (A), (B), and caption, p. 2	Fig. 1 (A), (B), and caption, p. 2: Identical
Fig. 2, including parts (A), (B), (C) and captions, p. 2	Fig. 2, including parts (A), (B), (C) and captions, p. 3: Identical
(continuation of) Results and Discussions	
First par., p. 3	First par., p. 3: Verbatim identical
Conclusions , p. 3	Second par., p. 3: Verbatim identical
Acknowledgments , p. 3	Although this element is not substantive and is probably irrelevant for present purposes, see nevertheless the "Provisional Application for Patent Cover Sheet," about 3/4 of the way down the page. See also the Application Data Sheet, p. 1, about 1/3 of the way down the page.
References (1) and (2), p. 3	References (6) and (7), respectively, p. 4: Verbatim identical, except for their numbering